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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/744,469	01/25/2001	Tony Kouzarides	620-128	8432

7590

07/23/2002

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EXAMINER

KAM, CHIH MIN

ART UNIT

PAPER NUMBER

1653

DATE MAILED: 07/23/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/744,469

Applicant(s)

KOUZARIDES, TONY

Examiner

Chih-Min Kam

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-18 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Applicant's election with traverse of Group II, claims 2, 3, 10 and 11 in Paper No. 9 (filed on May 17, 2002) is acknowledged, however, the previous restriction (Paper No. 7) is based on original claims (claims 1-23) because the preliminary amendment filed on January 25, 2001 was not entered at that time. The preliminary amendment is entered now, claims 8, 10, 12, 14, 17 and 18 have been amended, and claims 19-23 have been cancelled. Because of the change of the dependency of the claims, and cancellation of claims 18-23, claims 1-18 are restricted in this Office Action.

Election/Restrictions

Restriction is required under 35 U.S.C. 121 and 372.

This application contains the following inventions or groups of inventions, which are not so linked as to form a single general inventive concept under PCT Rule 13.1.

In accordance with 37 CFR 1.499, applicant is required, in response to this action, to elect a single invention to which the claims must be restricted.

1. Group I, claims 1, 10, 11 and 15-18, drawn to an assay method for identifying an agent which affects Importin α acetylation, and a peptide fragment of Importin α or CBP, or a nucleic acid encoding the peptide.
2. Group II, claims 2, 3, 4 and 9-11, drawn to an assay method for identifying an agent which affects Importin α activity.
3. Group III, claims 5-8, 10 and 11, drawn to an assay method for identifying an agent which affects ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein.

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4. Group IV, claims 12 and 13, drawn to an assay method for identifying an agent which affects Importin α acetylation and further for providing the agent to cells to modulate the ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein.
5. Group V, claims 12 and 13, drawn to an assay method for identifying an agent which affects Importin α activity and further for providing the agent to cells to modulate the ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein.
6. Group VI, claims 12 and 13, drawn to an assay method for identifying an agent which affects ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein and further for providing the agent to cells to modulate the ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein.
7. Group VII, claim 14, drawn to an assay method for identifying an agent which affects Importin α acetylation and further for using the agent for manufacturing of a medicament for treating a disorder of Importin α activity.
8. Group VIII, claim 14, drawn to an assay method for identifying an agent which affects Importin α activity and further for using the agent for manufacturing of a medicament for treating a disorder of Importin α activity.
9. Group IX, claim, drawn to an assay method for identifying an agent which affects ability of Importin α to bind Importin β , to translocate into the nucleus, or to import a cargo protein and further for using the agent for manufacturing of a medicament for treating a disorder of Importin α activity.

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Should Group I, II, III, IV, V, VI, VII, VIII or IX be elected, applicant is required to select either peptide or nucleic acid because peptide and nucleic acid are two distinct chemical entities, have different chemical and physical properties, and have different utilities.

The claims of these groups are directed to different inventions, which are not linked to form a single general concept. The claims in the different groups do not have in common the same or corresponding technical features. In particular, each group is directed to distinct chemical entities and/or methods, which use different materials and produce different effects. Accordingly, the claims are not so linked by a special technical feature within the meaning of PCT Rule 13.2 so as to form a single inventive concept and lack of unity is deemed proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement is traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chih-Min Kam whose telephone number is (703) 308-9437. The examiner can normally be reached on 8.00-4:30, Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low can be reached on (703) 308-2923. The fax phone numbers for the

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organization where this application or proceeding is assigned are (703) 308-0294 for regular communications and (703) 308-4227 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Chih-Min Kam, Ph. D.
Patent Examiner

CMK

July 22, 2002

Karen Cochrane Carlson

KAREN COCHRANE CARLSON, PH.D.
PRIMARY EXAMINER